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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,347	08/24/2001	Ali Yahiaoui	15,876	1332

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NEENAH, WI 54956

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,347

Applicant(s)

YAHIAOUI ET AL.

Examiner

JYOTHSNA A VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/14/04 has been entered.

Claims 36-41 have been added as per applicant's amendment dated 7/14/04. Claims 1-41 are pending in the application and the status of the application is as follows:

The following new rejection is necessitated by the amendment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

4. There is no support in the specification for the expression “boundary layer comprising hydrocarbon emollient”.

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5. In accordance with MPEP 714.02, applicants should specifically point out support for any amendments made to the disclosure.

6. Claims 36-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are unclear as to applicant's intent. One set of claims recite "comprising" and another set of claims recite "consisting essentially of". What is the scope of "consisting essentially of"? What is the difference between "comprising myristyl myristate" and consisting essentially of "myristyl myristate"? Which component is excluded for "consisting essentially of myristyl myristate"? Detailed explanation is requested

The following rejections are maintained for reasons of record.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 17 is in the improper Markush group because of the expression "comprises". *Deletion of "comprises"* is suggested to overcome the above rejection.

Response to Arguments

3. Applicant's arguments filed 7/14/04 have been fully considered but they are not persuasive.

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Applicants argue that claim 17 is proper and “or ‘ terminology is acceptable and argue that there is no ambiguity in the expression as currently recited in Claim 17. The nonwoven web of the composite material claimed includes either a spun bond web, a melt blown web, a coformed web or a bonded carded web and can include a laminate including at least any one of those materials and therefore claim 17 is definite within the meaning of 35 U.S.C. second paragraph.

In response to the above argument, it is the position of the examiner that the expression “comprises” followed by the Markush members are in the improper Markush group format. Deletion of “comprises” and amending to “is ‘ suggested to overcome the above rejection or the claim 17 can be written like claim 15.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-13 and 15-35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent 6,287,581 B1 ('581).

The instant application is claiming-*A composite material comprising:*

A substrate having first and second surface

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A boundary layer on the first surface of the substrate

A topical application on the surface of the boundary layer opposite of the substrate, where in the boundary layer has compositions comprising ingredients (claims 10-13) and also method of forming composite material for transferring the topical application from substrate to surface.

The examiner interprets the meaning of blend is same as combination.

See figures, See cols. 4-10 for the various ingredients. In each choice of ingredients the patent discloses “ mixtures” which implies “ blend or combination”. See col.4, lines 5-15 for soy sterol, see col.5, lines 10-50 for various compositions which includes claimed petrolatum, soy sterol, ozokerite wax, ethylene/vinalacetatecopolymer, see also col.8, line 58 for sunflower oil. See col.10, lines 43 et seq see col.14, lines 40 et seq for the various materials, see cols 15-16 for the description of the figure, see col.17, lines 35-40, which reads on claim 32, see col.14, lines 64 et seq, which reads on claim 5, see col.14, lines 1-15 which reads on claim 33, see also the examples and tables. Since the components are same, claims 2-3, 8, 25-27 and 29-30 are inherent absence of evidence to the contrary.

Response to Arguments

6. Applicant's arguments filed 7/14/04 have been fully considered but they are not persuasive.

7. The gist of applicant's argument is that the patent '581 fails to disclose a boundary layer comprising hydrocarbon emollient between the skin care composition and the substrate and the boundary layer is not blended with the topical application as described in the reference and the patent fails to disclose a boundary layer wherein the transfer forces necessary to separate the

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topical application from the boundary layer are lower than the transfer forces necessary to separate the substrate from the boundary layer.

8. In response to the above argument, the patent '581 discloses a body sideliners, which is met by a "boundary layer on the first side of the substrate". Absorbent core of the patent reads on the "substrate". The patent at col.16, lines 39-40 disclose that the body sideliners 18 contains an effective amount of the composition. With respect to applicants argument that the boundary layer having "hydrocarbon emollient", the expression is new matter.

9. Claims 1-11 and 15-35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,153,209 ('209).

The instant application is claiming *A composite material comprising:*

A substrate having first and second surface

A boundary layer on the first surface of the substrate

A topical application on the surface of the boundary layer opposite of the substrate, where in the boundary layer has compositions comprising ingredients (claims 10-11) and also method of forming composite material for transferring the topical application from substrate to surface.

See figures, See col. 15, lines 56 et seq for the claimed petrolatum based, see col.s 15-26 for the various ingredients claimed in claim 10, see col.6, lines 40 et seq for the various materials, see cols .8-12 for the description of the figures, see col.30, col.31, lines 20-30, which reads on claim 32, see col.10, lines 45-55, which reads on claim 5, see col.10, lines 20-30, which reads on claim 31, see also the examples. Since the components are same, claims 2-3, 8, 25-27, and 29 are inherent.

Response to Arguments

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10. Applicant's arguments filed 7/14/04 have been fully considered but they are not persuasive.

Applicants argue that the patent , fails to disclose a boundary layer between the skin care composition and the substrate and point out that a top sheet is not a boundary layer but the top sheet of the patent could be a substrate of the present patent application, however, no boundary layer is disclosed, taught or suggested by the patent.

Applicants argue that the patent '209 fails to disclose a boundary layer between the a topical application and a substrate and fails to disclose a boundary layer, wherein the transfer forces necessary to separate a topical application from the boundary layer are lower than the transfer forces necessary to separate the substrate from the boundary layer.

11. In response to the above argument, it is still the examiners position that the patent '209 discloses " top sheet" which reads on the " boundary layer " claimed in the instant application. The " absorbent core" reads on the substrate claimed in the instant application . The top sheet is facing the wearer skin and the composition is applied on top sheet . See col.31, lines 20-30 . Since the components are same , the functional language recited in the claims is inherent. Applicants amended the expression " hydrocarbon emollient" which is new matter.

Allowable Subject Matter

12. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

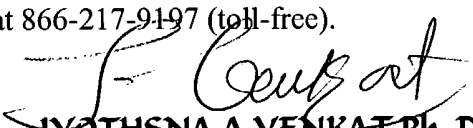
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT Ph. D whose telephone number is 571-

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272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
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